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10/563,026	12/30/2005	Owen Derek Barr	RICE-042	6051
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BOZICEVIC, FIELD & FRANCIS LLP			EXAMINER	
1900 UNIVERSITY AVENUE			CAJILIG, CHRISTINE T	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,026	<b>Applicant(s)</b> BARR, OWEN DEREK
	<b>Examiner</b> CHRISTINE T. CAJILIG	<b>Art Unit</b> 3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 30 December 2005.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 34-58 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 34-58 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 December 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/06/08)  
Paper No(s)/Mail Date 12/30/05.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "layer (a) is wider than layer (b)" as recited in claim 41 and "the backing layer [including] a mesh layer" as recited in claim 50 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: Page 5 contains a typographical error, "Figure 2 shoes a second embodiment." Page 6 uses the reference number "12" to denote both a blanket (line 3) and a paper backing layer (line 17).

Appropriate correction is required.

### ***Claim Objections***

Claims 34, 35, 38, 41, 43-45, and 53 are objected to because of the following informalities: Claims 34 and 35 contains a second period instead of a semi-colon in "solid object." See last line of item (b) of claims 34 and 35. Claims 34, 35, 38, 41, 43-45, and 53 refer back to "layer (a)" or "layer (b)." However, such notation does not definitively set forth the layer refer to. The examiner suggests to instead use "the fabric layer" or "the backing layer" as used in dependent claims 46 or 47. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50 recites, "the backing layer includes a mesh layer." However, such recitation is contrary to the description of the backing layer as disclosed in paragraphs 18, 34, 39, 56 of this Applications' publication. The specification fails to state that the backing layer includes mesh, and instead, recites that the backing layer comprises paper and foil.

Regarding claim 55, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34, 35, 38, 46, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffmann, Sr. (U.S. Patent No. 5,620,768).

Regarding claim 34, Hoffmann, Sr. discloses a multi-layer covering for application to a building or other solid object and which supports an outer coating, the multi-layer covering including a first layer comprising: a fabric layer (13) defining an outer surface of the multi-layer covering, the fabric layer being porous, resilient and flexible and allowing penetration by the outer coating, in use, and being selected from the group consisting of: a strong woven fabric blanket (13); a non-woven fabric or batt; a mesh layer (13); and wherein the multi-layer covering further comprises: a second layer being a backing layer (11, 12) fixed to the fabric layer, the backing layer being a web which strengthens and combines with layer to provide strength to the same to allow the fabric layer to bridge cracks and gaps in the base object and wherein a series of through holes (19, 23) are present in the second layer and *wherein, in use, when the multi-layer covering is applied to a building or other solid object, and an outer coating applied, the holes allow the outer coating to penetrate through the second layer to the building or other solid object* a bonding layer or a means (25) bonding the second layer to the fabric layer; an adhesive layer (24) disposed on the opposite side of the backing layer to the fabric layer; and a sacrificial or removable peel-off layer (17) protecting the adhesive layer.

Regarding claim 35, Hoffmann, Sr. further discloses that the holes in the backing layer comprise a grid of blister holes (19, 23) punched through that layer.

Regarding claim 38, Hoffmann, Sr. further discloses a grid of through holes is defined in at least layers (a) and (b) of the multi-layer covering.

Regarding claim 46, Hoffmann, Sr. further discloses that the fabric layer is made from a plastics material such as fibre glass or PET fibres (Col 7, Ln 17-18).

Regarding claim 50, Hoffmann, Sr. further discloses that the backing layer includes a mesh layer, and the fabric layer is a strong woven fabric or a non-woven fabric or batt.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-40, 42, 43, 45, and 47-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Shickel (U.S. Patent No. 4,902,550) in view of Byrd et al. (U.S. Patent No. 6,123,172).

Regarding claim 34, Shickel discloses a multi-layer covering *for application to a building or other solid object and which supports an outer coating*, the multi-layer covering including a first layer comprising: a fabric layer (20, 26, 32) defining an outer surface of the multi-layer covering, the fabric layer being porous, resilient and flexible and allowing penetration by the outer coating, in use, and being selected from the group consisting of: a strong woven fabric blanket ; a non-woven fabric or batt (20, 26, 32); a mesh layer (13); and wherein the multi-layer covering further comprises: a second layer being a backing layer (11, 12) fixed to the fabric layer, the backing layer being a web

which strengthens and combines with layer to provide strength to the same to allow the fabric layer to bridge cracks and gaps in the base object and wherein a series of through holes (19, 23) are present in the second layer and *wherein, in use, when the multi-layer covering is applied to a building or other solid object, and an outer coating applied, the holes allow the outer coating to penetrate through the second layer to the building or other solid object*; and a bonding layer or a means (Col 6, Ln 19-27) bonding the second layer to the fabric layer.

Shickel does not disclose an adhesive layer disposed on the opposite side of the backing layer to the fabric layer; and a sacrificial or removable peel-off layer protecting the adhesive layer.

Byrd et al. discloses an insulating, self-adhesive sheet wherein the back of the sheet comprises adhesive (50) covered by a removable peel-off layer (52) to facilitate installation on a surface (Col 10, Ln 34-39).

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Shickel to include an adhesive backing layer to facilitate installation and with a removable peel-off layer to protect the adhesive during packaging.

Regarding claim 35, Shickel modified by Byrd et al. further discloses that the holes in the backing layer comprise a grid of blister holes punched through the backing layer.

Regarding claim 36, Shickel modified by Byrd et al. further discloses that the holes have a diameter of 0.5 mm to 10 mm and the holes are spaced apart by 10 mm to 300 mm (Col 3, Ln 53-59).

Regarding claim 37, Shickel modified by Byrd et al. further discloses that the holes have a diameter of 0.6 mm to 5 mm, and the holes are spaced apart by of 10 mm to 50 mm (Col 3, Ln 53-59).

Regarding claim 38, Shickel modified by Byrd et al. further discloses that a grid of through holes is defined in at least the fabric layer and the backing layer.

Regarding claim 39, Shickel modified by Byrd et al. further discloses that the holes have a diameter of 0.5 mm to 10 mm and the holes are spaced apart by of 10 mm to 300 mm (Col 3, Ln 53-59).

Regarding claim 40, Shickel modified by Byrd et al. further discloses that the holes have a diameter of 0.6 mm to 5 mm, and the holes are spaced apart by of 10 mm to 50 mm (Col 3, Ln 53-59).

Regarding claims 42, 43, and 45, Shickel modified by Byrd et al. further discloses that the flexible, porous, resilient strong woven fabric or non-woven fabric or batt has a thickness from 2 mm to 5 mm, the fabric being made from fibres or strands and wherein either gaps between fibres in the fabric are defined in the range of 0.3 mm to 3.0 mm or holes having a diameter of 0.3 mm to 3.0 mm are defined in the fabric.

Shickel in column 4, lines 7-16 further discloses that although the fabric layer is about 3 inches thick, the thickness of such layer may be substantially reduced depending on the desired level of thermal resistance.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Shickel modified by Byrd et al. to have the fabric layer with a thickness from 2 mm to 5 mm since a person with ordinary skill has good reason to pursue known options within his or her technical grasp.

Moreover, it would have been obvious to one having ordinary skill in the art at the time of invention to use a woven or non-woven fabric or batt material having a spacing of 0.3 to 3.0 mm between strands, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and would allow for more adhesion of subsequent coatings on the fabric layer. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 47, Shickel modified by Byrd et al. further discloses that the backing layer is a metallic reflective foil (44).

Regarding claim 48, Shickel modified by Byrd et al. further discloses that the backing layer includes a metallic reflective foil (44) and building paper (46).

Regarding claim 49, Shickel modified by Byrd et al. further discloses that the backing layer is a building paper (46).

Regarding claim 50, Shickel modified by Byrd et al. further discloses that the backing layer includes a mesh layer (46), and the fabric layer is a strong woven fabric or a non-woven fabric or batt.

Regarding claim 51, Shickel modified by Byrd et al. further discloses that the backing layer further includes a metallic reflective foil.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shickel in view of Byrd et al. as applied to claim 34 above, and further in view of Beaupre (U.S. Patent No. 4,310,587).

Regarding claim 52, Shickel modified by Byrd et al. further discloses that the backing layer includes metallic foil and a sheet of building paper, but does not disclose that the backing layer includes two metallic reflective foils sandwiching a sheet of building paper.

Beaupre discloses a building covering with a backing comprising a paper layer sandwiched between two metallic reflective foils (26, 28) to provide fire resistant backing.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Shickel modified by Byrd et al. to have the paper layer sandwiched between two metallic foils as taught by Beaupre to provide a fire resistant backing layer.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann, Sr. '768 in view of Hoffmann, Sr. (U.S. Patent No. 4,135,017).

Regarding claim 41, Hoffmann, Sr. discloses the structure discussed above, but does not disclose that the fabric layer is wider than the backing layer so that the fabric layer overlaps the backing layer at opposite sides of the backing layer.

Hoffmann, Sr. '017 discloses a multi-layer covering wherein an upper fabric layer (16) is wider than a backing layer (12) to provide flanges that facilitate blending of the covering to a wall.

It would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify Hoffmann, Sr. '768 to have the fabric layer wider than the backing layer so that the fabric layer overlaps the backing layer at opposite sides of the backing layer as taught by Hoffmann, Sr. '017 to provide flanges that facilitate blending of the covering to a wall.

Claims 44, 53, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann, Sr. (U.S. Patent No. 5,620,768).

Regarding claim 44, Hoffmann, Sr. discloses the structure discussed above, but does not disclose that the fabric layer is a flexible mesh layer that defines a spacing between strands of the mesh of 3 mm to 20 mm.

It would have been obvious to one having ordinary skill in the art at the time of invention to use a mesh material having a spacing of 3-20mm between strands, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design

choice and would allow for more adhesion of subsequent coatings on the mesh layer. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 53, Hoffmann, Sr. discloses the structure of a multi-layer covering as discussed in claim 34 above, and the method of using the multi-layer covering comprising the steps of: removing the removable or sacrificial peel off layer from the multi-layer covering; applying the multi-layer covering to the wall using the adhesive layer to retain the multi-layer covering in position; and applying one or more coatings (35) to the outer layer of the multi-layer covering would have been obvious method steps of employing the multi-layer covering and patching a damaged portion of a wall.

Regarding claims 57 and 58, Hoffmann, Sr. further discloses that the covering may be applied to any damaged part of a building or the top of a vehicle, and may obviously be applied to a roof or floor and the coating is an adhesive or sealant (bonding agent 35).

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann, Sr. (U.S. Patent No. 5,620,768) in view of Swallow (U.S. Patent No. 5,820,958).

Regarding claim 54, Hoffmann, Sr. discloses the method steps disclosed above, but does not disclose that the step of applying one or more coatings comprises applying one or more layers of acrylic render or paint.

Swallow discloses a method of treating a wall wherein coatings of bonding agent and paint is applied to provide the multi-layer coating with a decorative surface (Col 6, Ln 61-64).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the method of Hoffmann, Sr. to further include the step of applying paint as taught by Swallow to provide the multi-layer covering with a decorative finish.

Regarding claim 55, Hoffmann, Sr. modified by Swallow discloses the method steps disclosed above, but does not disclose that the coating is a render or paint applied with a brush, roller, or spray gun.

However, applying paint with a brush, roller, or spray gun is old and well known in the art as a customary means to apply paint onto any surface, and application of paint by such methods would have yielded predictable results to one having ordinary skill in the art of being able to expediently apply paint.

Regarding claim 56, Hoffmann, Sr. modified by Swallow discloses the method steps disclosed above and further discloses that the particles of the paint or render would inherently penetrate into the caps between the fibres of the fabric or the holes in the backing layer as far as the face of the wall so that the covering is saturated with acrylic render or paint.

Hoffman, Sr. modified by Swallow does not disclose that the paint or render includes cement and/or sand particles and an acrylic polymer binder.

It would have been obvious to one having ordinary skill in the art at the time of invention to use paint or render that includes cement, and/or sand particles, and acrylic polymer binder since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and would allow for more adhesion of the coating on the mesh layer. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brueske (US 4557092) roof insulation; Sylvest (US 4315392) roof insulation; Bussey, Jr. et al. (US 5766721) siding insulation; White (US 5346565) water barrier; Larsen (US 3795180) drainage mat.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE T. CAJILIG whose telephone number is (571)272-8143. The examiner can normally be reached on Monday - Thursday from 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571) 272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. T. C./  
Examiner, Art Unit 3633  
/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635